

U.S. Application No. 09/697,703

Docket No. 4450-0160P

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REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-23 remain pending. Claims 1, 12, and 19 are independent.

§ 103 REJECTION - BULOW, CAO

Claims 1-4, 9, 12-16, 19, and 21-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bulow (U.S. Patent No. 5,793,511) in view Cao (U.S. Patent No. 6,130,766). Applicant respectfully traverses and maintains the traversal argument made in the Rule 111 Reply filed on August 12, 2003.

In the May 22, 2003 Office Action and the November 6, 2003 Final Office Action, the Examiner asserts that the polarization mode dispersion compensator element (as claimed in independent claims 1, 12, and 19) is taught by the optical polarization controller 1.7 as shown in Figure 1 of Bulow.

Applicant respectfully disagrees. More specifically, the claims further recite "an output of said polarization mode dispersion compensator serving as **an output of the polarization mode dispersion compensating apparatus.**" *Emphasis added.* However, in

the optical receiver apparatus as disclosed in Figure 1 of Bulow, the optical polarization controller 1.7 only has a single output. This single output is connected **only** to the optical splitter 1.6, which is entirely within the optical receiver apparatus. Simply put, the output of the optical polarization controller 1.7 **cannot** serve as the output of the apparatus.

Then, it is also clear that Bulow cannot be relied upon to teach or suggest the feature of "a polarimeter optically coupled to the output of said polarization mode dispersion compensator" as previously argued in the August 12, 2003 Reply.

Cao has not been, and indeed cannot be, relied upon to correct at least the above noted deficiencies of Bulow.

In addition, Applicant respectfully maintains that Bulow and Cao may not be properly combined. Applicant recognizes that the test for determining obviousness is what the combined teachings of the references would have suggested to one of ordinary skill. However, in making that determination, the references must be considered in a proper manner to establish a *prime facie* case of obviousness.

For example, one requirement to establish *prima facie* case of obviousness is that there must be a suggestion or motivation

within the cited reference(s) to modify the reference(s) as proposed in the Office Action. See *M.P.E.P.* 2143.01.

In this instance, the Examiner indicates that dithering is very well known and therefore, one skilled in the art would have been motivated to dither the wavelength of an input signal in order generate an electrical dithering output control signal to a laser. See *Final Office Action*, page 3, lines 2-7. Just because something is well known is not enough to establish motivation. It is noted that no line of reasoning is provided as to why one of ordinary skill would be motivated to dither. The Examiner failed to provide any motivation as to why generating an electrical dithering is desirable and failed to establish that such motivation is present in either Bulow or Cao.

Another requirement to establish *prima facie* case of obviousness is that the cited reference(s) must be considered in their entirety. See *M.P.E.P.* 2141.02. If the proposed modification renders one or more reference unsatisfactory for its intended purpose, then by definition, there is no suggestion or motivation to make the proposed modification. See *M.P.E.P.* 2143.01.

In this instance, it has been shown in the August 12, 2003 Reply that Bulow specifically states equalization of the polarization mode dispersion takes place **exclusively in the electrical part** of the device. See column 3, lines 44-49. On the other hand, it has been shown that Cao states correcting for polarization mode dispersion **optically**. Thus, to the extent that Bulow teaches equalizing exclusively in the electrical domain and Cao specifies that the principal mode dispersion is corrected in the optical domain, modifying one with the teachings of the other renders either reference unsatisfactory for its intended purpose, and thus the references may not properly be combined.

Even if Bulow and Cao are unreasonably combined, the references must teach or suggest all claim limitations. See *M.P.E.P.* 2142; *M.P.E.P.* 706.02(j). Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

However, in this instance, it has been shown above that neither Bulow nor Cao may be relied upon to teach or suggest "an output of said polarization mode dispersion compensator serving as **an output of the polarization mode dispersion compensating apparatus**" and cannot be relied upon to teach or suggest "a

polarimeter optically coupled to the output of said polarization mode dispersion compensator."

Therefore, claims 1, 12, and 19 are distinguishable over the combination of Bulow and Cao.

Claims 1-4, 9, 13-16, and 21-23 depend from independent claims 1 and 12 directly or indirectly. Therefore, for at least the reasons stated with respect to independent claims 1 and 12 as well as on their own merits, these dependent claims are also distinguishable over the combination of Bulow and Cao.

Applicant respectfully requests that the rejection of claims 1-4, 9, 13-16, and 21-23 based on Bulow and Cao be withdrawn.

§ 103 REJECTION - BULOW, CAO, FISHMAN

Claims 5-9, 17, 18, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bulow in view of Cao and further in view of Fishman (U.S. Patent No. 5,930,414). Applicant respectfully traverses and maintains the traversal argument made in the Rule 111 Reply filed on August 12, 2003.

In addition, it is noted that claims 5-9, 17, 18, and 20 depend from independent claims 1, 12, and 19 and it has been shown that the independent claims are distinguishable over the combination of Bulow

and Cao. It has also been shown that Bulow and Cao may not properly be combined. Fishman has not been, and indeed cannot be, relied upon to correct at least these deficiencies of Bulow and Cao. Therefore, independent claims 1, 12, and 19 are distinguishable over the combination of Bulow, Cao, and Fishman.

For at least the reasons stated with respect to the independent claims 1, 12, and 19 as well as on their own merits, these dependent claims are also distinguishable over the combination of Bulow, Cao, and Fishman.

Applicant respectfully request that the rejection of claims 5-9, 17, 18, and 20 based on Bulow, Cao, and Fishman be withdrawn.

§ 103 REJECTION - BULOW, CAO, BERGANO

Claims 10 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bulow in view of Cao and further in view of Bergano (U.S. Patent No. 6,134,033). Applicant respectfully traverses and maintains the traversal argument made in the Rule 111 Reply filed on August 12, 2003.

In addition, it is noted that claims 10 and 11 depend from independent claims 1, and it has been shown that the claim 1 is distinguishable over the combination of Bulow and Cao. It has also

been shown that Bulow and Cao may not properly be combined. Bergano has not been, and indeed cannot be, relied upon to correct at least these deficiencies of Bulow and Cao. Therefore, independent claim 1 is distinguishable over the combination of Bulow, Cao, and Bergano.

For at least the reasons stated with respect to the independent claim 1 as well as on their own merits, claims 10 and 11 are also distinguishable over the combination of Bulow, Cao, and Bergano.

Applicant respectfully request that the rejection of claims 10 and 11 based on Bulow, Cao, and Bergano be withdrawn.

#### **CONCLUSION**

All objections and rejections raised in the Final Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

**Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant respectfully petitions for a one (1) month extension of time for**

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**filing a reply in connection with the present application, and  
the required fee is attached hereto.**

If necessary, the Commissioner is hereby authorized in this,  
concurrent, and future replies, to charge payment or credit any  
overpayment to Deposit Account No. 02-2448 for any additional  
fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly,  
extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By: 

Michael R. Cammarata  
Reg. No. 39,491

*HNS*  
MRC/HNS/kmr  
4450-0160P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000